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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,978	12/11/2006	James W. Halbrook	N0260.70068US01	1639
23628 7590 08/18/2009 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206				
EXAMINER ANDERSON, REBECCA L				
ART UNIT		PAPER NUMBER		
1626				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,978

Applicant(s)

HALBROOK ET AL.

Examiner

REBECCA L. ANDERSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 9, 11, 20, 22-24, 30, 31, 33, 35, 36, 40 and 46-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1,9,11,20,22-24,30,31,33,35,36,40 and 46-53.

DETAILED ACTION

Claims 1, 9, 11, 20, 22-24, 30, 31, 33, 35, 36, 40 and 46-53 are currently pending in the instant application and are subject to a lack of unity requirement.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I. Claims 1, 9, 22 (in part), 23 and 24 drawn to products of the formula as found in claim 1. Further election of a single compound is required.

Group II. Claims 11, 20, 46 and 47 drawn products of the formula as found in claim 11. Further election of a single compound is required.

Group III. Claim 22 drawn to trifluoromethanesulfonic acid 1-hydroxy-9-oxo-9H-xanthen-3-yl ester.

Group IV. Claim 22 drawn to 1-hydroxy-6-methoxy-3-trifluoromethanesulfonylxanthen-9-one ester.

Group V. Claim 22 drawn to trifluoromethanesulfonic acid 1-hydroxy-9-oxo-9,10-dihydro-acridin-3-yl ester.

Group VI. Claim 30 drawn to a method of inhibiting NDA-PK activity with the compound of claim 1. Further election of a single compound is required.

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VII. Claim 31 drawn to a method of sensitizing a cell type with the compound of claim 1. Further election of a single compound is required.

Group VIII. Claim 33 drawn to a method of potentiating a therapeutic regimen with the formula of claim 1. Further election of a single compound is required.

Group IX. Claims 35 and 36 drawn to methods of characterizing the potency of a test compound with the compound of claim 1. Further election of a single compound is required.

Group X. Claim 40 drawn to an article of manufacture of the product of claim 1. Further election of a single compound is required.

Group XI. Claim 48 drawn to a method of inhibiting NDA-PK activity with the compound of claim 11. Further election of a single compound is required.

Group XII. Claim 49 drawn to a method of sensitizing a cell type with the compound of claim 11. Further election of a single compound is required.

Group XIII. Claim 50 drawn to a method of potentiating a therapeutic regimen with the formula of claim 11. Further election of a single compound is required.

Group XIV. Claims 51 and 52 drawn to methods of characterizing the potency of a test compound with the compound of claim 11. Further election of a single compound is required.

Group XV. Claim 53 drawn to an article of manufacture of the product of claim 11. Further election of a single compound is required.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since, under 37 CFR 1.475(a)

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among

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those inventions involving one or more of the same or corresponding special technical features...those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Groups I-XV lack unity of invention since under 37 CFR 1.475: the technical feature corresponding to the claims is a tricyclic ring structure substituted with an oxo group. This technical feature is not a special technical feature because it fails to define a contribution over the prior art as can be seen by the compounds in DE 3141970. (submitted on 1449). Therefore claims 1, 9, 11, 20, 22-24, 30, 31, 33, 35, 36, 40 and 46-53 are not so linked as to form a single general inventive concept and there is a lack of unity of invention because they lack a special technical feature as the technical feature present fails to define a contribution over the prior art. Additionally, the variables found on the formulas claimed vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter imposes a serious burden on any examination of the claimed subject matter.

Furthermore, in regards to groups I-XV even if unity of invention under 37 CFR 1.475(a) is not considered lacking, which it is, under 37 CFR 1.475(b) a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

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- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

And, according to 37 CFR 1.475(c)

if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b), unity of invention might not be present.

Therefore, since the claims are drawn to more than a product and a process of using said product and according to 37 CFR 1.475 (e)

the determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

The claims, therefore, lack unity of invention.

Therefore, since the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical feature, the claims lack unity of invention and should be limited to only a product, or a process of preparation.

This application contains Markush claims directed to more than one species. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The species lack the same or corresponding special technical feature.

The species are as follows: compounds encompassed by formula as found in claims 1 and 11 obtained by varying the substituents to the core structure, see for example, the species of claim 22 and examples 8-51 of the specification. Claims 1, 9, 11, 20, 22-24, 30, 31, 33, 35, 36, 40 and 46-53 encompass these species.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no Markush claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a Markush claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed Markush claim (MPEP 803.02). If claims are added after the election applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of an invention group and an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. The election of the invention and species may be made with or without traverse. To preserve a right to

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petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be

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maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b).

Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

14 August 2009

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